

REMARKS

Applicant has reviewed the Office Action mailed July 1, 2003. Claims 1, 6, 11, and 16 are being amended by this Response. Support for the amended claims may be found throughout the specification. Claims 1 through 19 are pending. Applicant hereby requests further examination and reconsideration of the application in view of the following remarks.

The Patent Office in the *Response to Argument* section of the Office Action mailed July 1, 2003 argues that the Mao reference teaches exactly the claimed step of “providing information associated with the subset of program information for the at least one related program;” as recited in independent claims 1, 6, 11, and 16. The Office argues that the disclosure in Mao of “MORECAST is used for offering additional information related to the programs being watched, i.e., advertisement related to programs being watched, or news related to the program being watched, even many users can access to different subset of the real time information of programs being broadcasted” makes obvious the claimed step as recited. Applicant respectfully submits, that the Office has failed to correctly ascertain and set forth the differences between the claimed invention and the prior art. Furthermore, independent claims 1, 6, 11, and 16 provide for “providing information on programs related through the at least one related program and associated with the subset of program information for the at least one related program”, which is not disclosed, taught, or suggested by the cited references. Accordingly, the rejection is untenable and should be reversed.

The method disclosed by Mao teaches transmitting digital web links along with digital video channels provides substantially simultaneous display of the digital web link data and the digital video channels. Mao does not disclose, teach, or suggest maintaining a subset of information for at least one program (intermediate programs) related to a given program and then also information on programs related to the given program through the at least one related program (intermediate program), as taught by the present invention. The MORECAST Simulcast Data is a Web-casting feature providing HTML data (hypertext links) within a multiple program transport stream for access by a user. While the HTML Web-casting content may include “programming provider’s key Web pages, advertisement related to the program, news related to the program,” (Col. 3, Lines

23-24) the 'subset' of information provided by Mao is not maintained by the invention claimed in Mao, but by websites. Therefore, it is the websites which are providing the additional information. Further, nowhere in the Mao reference does it suggest, teach, or disclose that the HTML data provided goes beyond providing information (as stated above) associated with the given program being viewed. Additionally, Mao teaches to a MORECAST Personalized Data which is a second HTML based Web-casting feature that provides access to "a different subset of the real time information during specific viewing periods." (Col. 3, Lines 29-30). This real time information may "include for example, Electronic Programming Guides, Navigation Pages, general community information, breaking news, weather, etc." (Col. 4, Lines 36-38). In combination with the reasons stated above, this is not the present invention. The present invention maintains a subset of information for at least one program (intermediate programs) related to a given program and then also information on programs related to the given program through the intermediate programs. Therefore, the present invention is maintaining and providing a different type of information - programs related to a given program through an intermediate program - and is not directed towards simultaneous transmission of website information and channel information, as recited by Mao.

Claim Rejection – 35 U.S.C. §103

Claims 1 through 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Matthews III, et al. (U.S. Patent No. 6,025,837) in view of Mao et al. (U.S. Patent No. 6,459,427/ or "Mao" hereinafter). Applicant respectfully traverses this rejection.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Independent claims 1, 6, 11, and 16 recite maintenance of "a subset of program information for at least one related program of a given program with program information for the given program in an information handling system" and "providing information on programs related through the at least one related program and associated with the subset of program information for the at least one related program" (emphasis added). The information on program related through the at least one related program and

associated with the subset of program information for the at least one related program includes: “episodes of recurring programs, segments of a multi-part program, programs with similar content, and programs related through an intermediate program An example of the last type of relationship could be a program that has content about bears’ feeding habits, including eating salmon. The bear program could be related to a program about stocking fish, including salmon, which is further related to a program about fishing in artificially stocked rivers.” (Specification, page 2, lines 7-13; page 12, line 16 to page 13, line 15) (emphasis added). Thus, the present invention provides information concerning related programs to the given program. However, the present invention also provides information on programs related, through the related programs (a.k.a., intermediate programs), to the given program. In other words, the present invention provides another subset of information, such as further alternative programs, which are related to the at least one related program which itself is a subset of information to the given program.

By contrast, the Matthews reference fails to disclose, teach or suggest “providing information on programs related through the at least one related program and associated with the subset of program information for the at least one related program” to a user (emphasis added). The Patent Office refers to column 9, line 56 to column 10, line 13 of the Matthews reference as disclosing maintenance of a subset of program information for at least one related program. This passage reads:

The EPG UI 110 also includes hyperlinks 140 integrated as part of the grid. The hyperlinks are supplied with the program records received from the headend 22. These hyperlinks can be inserted into the channel tiles 122, program tiles 124, or the description window 128. In the Fig. 5 illustration, the hyperlink “More” is provided in the description window 128 to reference target resources that contain additional information about this episode of the Seinfeld show. Other Hyperlinks in the description window 128 include “Last Week” which references a target resource containing information on the previous week episode, and “comedy club” which links to a target resource having video coverage of comedian Jerry Seinfeld performing at night clubs. The target resources referenced by the hyperlinks might be located at the headend (Fig. 1 implementation), or at an independent service provider (Fig. 3 implementation). The target resource might further be located locally, having been pre-cached by the system. For instance, the system might pre-cache supplemental information about certain shows before they air based on predictive

viewing tendencies, or as part of a promotional data broadcast advertising the show. This permits local interactive functionality between the viewer and viewer computing unit, in addition to full network interactive functionality between the viewer and the program provider.

Matthews column 9, line 56 to column 10, line 13 (emphasis added). The Matthews reference teaches a user interface which provides access to hyperlinks, which then provides websites that contain the “additional information about this episode”. Thus, it is not the user interface of the Matthews reference, but the websites that provide additional information. Further, as the Patent Office states, the user interface in the Matthews reference does not disclose, teach, or suggest “providing information on programs related through at least one related program and associated with the subset of program information for the at least one related program” to a user (emphasis added). Instead, the Matthews reference is limited in scope to providing hyperlinks to websites including information related to the current program. The scope of the supplemental information accessible through the hyperlinks, as outlined in the Matthews reference, is described in the Matthews reference at Fig. 1 and column 7, lines 16 through 21. This passage reads:

Examples of possible supplemental content include interactive questions or games related to the program, additional trivia on the movies or TV shows, advertisements, available merchandise or other memorabilia, Web pages to programs of similar type or starring the same actors/actresses, and so on.

Matthews column 7, lines 16 through 21. Thus, the scope of the Matthews reference does not include the limitation of “providing information on programs related through the at least one related program and associated with the subset of program information for the at least one related program” (emphasis added). To correct this defect the Patent Office offers the Mao reference. The Patent Office refers to col. 3/lines 20-34 and col. 4/lines 33-58 as disclosing “providing information associated with the subset of program information for the at least one related program” to a user. These passages read:

carousel that carries HTML data coming from specific Web sites for different type of services. The carousel is synchronous with the digital broadcast program contents. Examples include: programming provider’s key Web pages, advertisement related to the program, news related to the program, etc. The simulcast data is available to all the clients who are

tuning to the TV program segment that the data is associated with. MORECAST Personalized Data: HTML based Web-casting content is customized based on each user's individual profile and viewing time. Statistically, many users may want to access a different subset of the real time information during specific viewing period. This information is also associated with each MPEG TV program but may not be synchronized with TV content. It should be available all the time from the data carousel upon each user's demand.

Mao column 3, lines 20 through 34;

In accordance with the invention, the system of Fig. 1 will broadcast data in hypertext markup language (HTML) to all consumers associated with the headend 20. These include for example, Electronic Programming Guides, Navigation Pages, general community information, breaking news, weather, etc. These data will always be on the broadcast carousel for all the 6 MHZ channels so that the consumer can always have access to these HTML pages and watch television at the same time. To simulcast data, HTML content is associated with each digital or broadcast TV channel. For each MPEG-2 program with a multiple program transport stream, there is a data carousel that carries HTML data coming from the specific Web Site for different types of services. The carousel is synchronous with the digital broadcast program content. These include for example, provider's key Web pages, advertisement related to the program being watched, news related to the program being watched, etc. To send personalized data, HTML based Webcasting content may be customized based on each consumer's individual profile and viewing time. Statistically, many consumers may desire access to a different subset of the real time information during specific viewing periods. This information is also associated with each MPEG TV program but may not be synchronized with the TV content. It will be available all the time from the data carousel upon each consumer's demand.

Mao column 4, lines 33 through 58. The Mao reference teaches a broadcast system which synchronizes and transmits data in hypertext markup language along with a video content. The hypertext data provides links (hyperlinks like the Matthews reference) to other sites, such as Websites, which may include information on electronic programming guides, navigation pages, advertisements, news, weather, etc. While these links may or may not provide information related to the program being viewed, the broadcast system does not provide information on programs related through the at least one related program and associated with the subset of program information for the at least one related program to a user as disclosed by the instant application. Further, the "access a different subset of the real time information during specific viewing period" we are told is based

“on each user’s individual profile and viewing time” and not based on a program information for at least one related program as disclosed by the instant application.

Further, the “hyperlinks” in the Matthews reference are provided for the purpose of helping a viewer to identify Websites associated with a particular program. This is described in the Matthews reference column 4, lines 59-65. This passage reads:

By integrating the hyperlinks within the EPG UI, the viewer can readily identify supplemental information to the programs and access that information directly from the EPG. The viewer no longer needs to remember that there may be a Web site associated with a particular program or channel, nor is the viewer relegated to surfing the Internet from a separate machine to find any related content.

Matthews column 4, lines 59-67 (emphasis added). This identifies that the purpose of these hyperlinks, in the Matthews reference, is to provide Internet access to Websites through the EPG, not provide information on programs related through the at least one related program and associated with the subset of program information for the at least one related program (emphasis added).

Additionally, the Patent Office refers to Fig. 4/items 92, 96, 101, 104 and column 8, lines 20-67 of the Matthews reference as disclosing maintenance of a subset of program information for at least one related program. This passage reads:

Fig.4 shows a user interface unit, referenced generally as numeral 90, in more detail. The user interface unit 90 includes a processor 92, a volatile memory 94, and a program memory 96. The user interface unit 90 also has at least one receiver, and possibly two receivers, for receiving the video streams from the headend and the digital supplemental data from the headend or ISP. The first receiver is in the form of a tuner 98 which tunes to the channel or broadcast frequency to receive a video data stream from a program source, such as the headend or other program provider. The second receiver, referenced generally as 100, can be a second tuner for receiving the content over a cable or wireless distribution network, or a modem for receiving the supplemental content over the Internet or other data network.

The viewer computer runs an operating system 101 which supports multiple applications. The operating system 101 is stored in memory and executes on the processor. The operating system is preferably a multitasking operating system which allows simultaneous execution of multiple applications. The operating system 101 employs a graphical user

interface windowing environment which presents the applications or documents in specially delineated areas of the display screen called "windows." One preferred operating system is a Windows® brand operating system sold by Microsoft Corporation, such as Windows® 95 or Windows® NT or other derivative versions of Windows®. However, other operating systems which provide windowing environments may be employed, such as the Macintosh operating system from Apple Computer, Inc. and the OS/2 operating system from IBM.

A channel navigator application 102 is stored in program memory 96 and executes on the processor 92 to control the tuner(s) 98 and 100 to select a desired channel for receiving the video content programs. An EPG application 104 is stored in program memory 96 and executes on the processor 92 to organize programming information downloaded from the EPG server at the headend. The EPG 104 supports a displayable user interface (UI) which visually correlates programs titles to scheduled viewing times and tuning information, such as a channel, as will be described below with reference to Fig. 5. The user interface unit 90 also has a browser 106 which is kept in memory 96 and dynamically loaded on processor 92 when needed to render content, such as a hypertext document, from an ISP or other content provider. The browser can be implemented as a hyperlink browser, or more particularly, as an Internet Web browser.

Matthews, column 8, lines 20-67 (emphasis added). However, this "EPG application" in the Matthews reference does not include providing program information on programs related through the at least one related program and associated with the subset of program information for the at least one related program, as is disclosed by the present application. Instead, it includes organizing "programming information downloaded from the EPG server at the headend" and supporting "a displayable user interface." In other words, the application 104 in Matthews only inserts the appropriate data records it receives in the appropriate location of the EPG user interface. As discussed above, the "More" hyperlink, which application 104 is responsible for appropriately locating, provides "supplemental information" regarding only the selected program and does not provide information on programs related through the at least one related program and associated with the subset of program information for at least one related program. Thus, a user of the system disclosed in Matthews is not able to retrieve information on programs related through at least one related program and associated with

the subset of program information for the at least one related program as recited in independent claims 1, 6, 11, and 16, and the claims depending therefrom.

Claims 2, 7, and 12 are believed to be allowable based on dependence from independent claims 1, 6, 11, and 16, respectively. However, the rejections of the dependent claims are respectfully traversed for the following additional reasons.

Dependent Claim 2 recites “maintaining the program information for the given program, including the subset of program information for the at least one related program, in an electronic program guide (EPG)” (emphasis added).

By contrast, the Matthews reference fails to disclose, teach or suggest maintenance of “the subset of program information for the at least one related program....” The Patent Office refers to Fig. 5 as illustration for an EPG, and Fig. 4/item 96 for a program memory for maintaining the program information EPG in section 104 of the Matthews reference as disclosing maintenance of a subset of program information for at least one related program. However, column 8, lines 54-57 of the Matthews reference clearly identifies the purpose and function of section 104, this passage reads:

An EPG application 104 is stored in program memory 96 and executes on the processor 92 to organize programming information downloaded from the EPG server at the headend.

Matthews column 8, lines 54-56 (emphasis added). Thus, application 104 of the EPG does not maintain a subset of information on at least one related program. Instead, application 104, simply organizes “programming information downloaded from the EPG server at the headend.” Matthews column 8, lines 55-56.

Dependent claim 7 recites “wherein said program of instructions further includes instructions configured to maintain the program information for the given program, including the subset of program information for the at least one related program, in an electronic program guide (EPG)” (emphasis added).

By contrast, the Matthews reference fails to disclose, teach or suggest maintenance of “the program information for the given program, including the subset of program information for the at least one related program, in an electronic program guide (EPG)”. The Patent Office refers to Fig. 4 and column 8/lines 20-67 of the Matthews

reference as disclosing maintenance of the program information for the given program, including the subset of program information for the at least one related program, in an electronic program guide (EPG). The relevant section of this passage reads:

A channel navigator application 102 is stored in program memory 96 and executes on the processor 92 to control the tuner(s) 98 and 100 to select a desired channel for receiving the video content programs. An EPG application 104 is stored in program memory 96 and executes on the processor 92 to reorganize programming information downloaded from the EPG server at the headend. The EPG 104 supports a displayable user interface (UI) which visually correlates programs titles to scheduled viewing times and tuning information, such as a channel, as will be described below with reference to Fig. 5. The user interface unit 90 also has a browser 106 which is kept in memory 96 and dynamically loaded on processor 92 when needed to render content, such as a hypertext document, form an ISP or other content provider. The browser can be implemented as a hyperlink browser, or more particularly, as an Internet Web browser.

Matthews column 8, lines 52-67. As can be seen from the Matthews reference, Fig. 4 and the written description of column 8, lines 52-67, it is a “program memory 96” which in fact stores a “operating system 101”, “channel navigator application 102”, “EPG application 104” and a “browser 106” and not the electronic program guide which is maintaining program information for the given program, including the subset of program information for the at least one related program.

Dependent claim 12 recites “[t]he computer readable medium of Claim 11 wherein said program of instructions further implements maintaining the program information for the given program, including the subset of program information for the at least one related program, in an electronic program guide (EPG)” (emphasis added). The Patent Office refers to the reasons given in the scope of method and system claims 2 and 7 for making this rejection. However, this rejection fails for the same reasons as stated for the failure of the rejections of claims 2 and 7.

Claims 3, 8, 13, and 17 are believed to be allowable based on their dependence from independent claims 1, 6, 11, and 16, respectively. However, the rejection of the claims is respectfully traversed for the following additional reasons.

Dependent claims 3, 8, 13, and 17 recite obtaining user input based on the information provided and performing program events based on the user input. This

includes obtaining user input and performing program events based on user input from the information associated with the subset of program information for the least one related program of the given program provided by independent claims 1, 6, 11, and 16 from which claims 3, 8, 13, and 17 depend.

By contrast, the Matthews reference fails to disclose, teach, or suggest the providing of information associated with the subset of program information for the least one related program of the given program. The Patent Office refers to Fig. 5, and column 9/line 55 to column 10/line 14 of the Matthews reference as disclosing the providing of information associated with the subset of program information for the at least one related program. The Patent Office argues that this is accomplished by the “MORE” 140 hyperlink, the “Last week” hyperlink and the “Comedy Club” hyperlink of the Matthews reference, which a viewer can access through the EPG. For the same reasons, as stated under the argument for independent claim 1, this argument fails.

The EPG UI 110 also includes hyperlinks 140 integrated as part of the grid. The hyperlinks are supplied with the program records received from the headend 22. These hyperlinks can be inserted into the channel tiles 122, program tiles 124, or the description window 128. In the Fig. 5 illustration, the hyperlink “More” is provided in the description window 128 to reference target resources that contain additional information about this episode of the Seinfeld show. Other Hyperlinks in the description window 128 include “Last Week” which references a target resource containing information on the previous week episode, and “comedy club” which links to a target resource having video coverage of comedian Jerry Seinfeld performing at night clubs. The target resources referenced by the hyperlinks might be located at the headend (Fig. 1 implementation), or at an independent service provider (Fig. 3 implementation). The target resource might further be located locally, having been pre-cached by the system. For instance, the system might pre-cache supplemental information about certain shows before they air based on predictive viewing tendencies, or as part of a promotional data broadcast advertising the show. This permits local interactive functionality between the viewer and viewer computing unit, in addition to full network interactive functionality between the viewer and the program provider.

Matthews column 9, line 56 through column 10, line 13 (emphasis added). The Matthews reference teaches a user interface which provides access to hyperlinks, which then provide websites that contain the “additional information about this episode”. Thus, it is not the user interface of the Matthews reference but the websites that provide

additional information. Further, the user interface in the Matthews reference does not disclose, teach, or suggest providing information on programs related through at least one related program and associated with the subset of program information for the at least one related program to a user, as disclosed by the present application; instead, the Matthews reference is limited in scope to providing hyperlinks to websites including information related to the current program. The scope of the supplemental information accessible through the hyperlinks, as outlined in the Matthews reference, is described in the Matthews reference at Fig. 1 and column 7, lines 16 through 21. This passage reads:

Examples of possible supplemental content include interactive questions or games related to the program, additional trivia on the movies or TV shows, advertisements, available merchandise or other memorabilia, Web pages to programs of similar type or starring the same actors/actresses, and so on.

Matthews column 7, lines 16 through 21. Thus, the scope of the Matthews reference does not include the limitation of providing information on programs related through the at least one related program and associated with the subset of program information for the at least one related program (emphasis added). The “hyperlinks” in the Matthews reference are provided for the purpose of helping a viewer to identify websites associated with a particular program. This is described in the Matthews reference column 4, lines 59-65. This passage reads:

By integrating the hyperlinks within the EPG UI, the viewer can readily identify supplemental information to the programs and access that information directly from the EPG. The viewer no longer needs to remember that there may be a Web site associated with a particular program or channel, nor is the viewer relegated to surfing the Internet from a separate machine to find any related content.

Matthews column 4, lines 59-67 (emphasis added). This identifies that the purpose of these hyperlinks, in the Matthews reference, is to provide Internet access to websites through the EPG, not to provide information on programs related through the at least one related program and associated with the subset of program information for the at least one related program (emphasis added).

Claims 4, 5, 9, 10, 14, 15, 18, and 19 are believed to be allowable based on dependence from independent claims 1, 6, 11, and 16. However, the rejection of the dependent claims is respectfully traversed for the following additional reasons.

Dependent claim 4 recites “wherein the action of performing program events includes recording the given program and the at least one related program” (emphasis added).

By contrast, the Matthews reference fails to disclose, teach or suggest the recording of a given program and the at least one related program. The Patent Office refers to Fig. 8/step 216 and column 12/lines 18-29 of the Matthews reference as disclosing the recording of a given program and the at least one related program. This passage reads:

On the other hand, suppose that the time is only 8:00 PM, and the Seinfeld program is not scheduled to start for another hour. In this case (i.e., the “no” branch from step 210), the user interface unit can perform one or two operations. First, the user interface unit can invoke some code to reference a target resource having information on the Seinfeld program (step 214 in Fig. 8). For instance, the instruction might call for invoking the Web browser 106 to render an NBC Web page for information on “Seinfeld.” A second operation might be to initiate a routine which will record the program “Seinfeld” when the program begins playing at 9:00 PM (step 216 in Fig. 8)

Matthews column 12, lines 18-29 (emphasis added). However, this “routine which will record the program Seinfeld” in the Matthews reference does not include recording an at least one related program as well. Instead, the “routine” is only enabled to record the given program “Seinfeld” or invoke a Web browser.

Dependent claim 5 recites “wherein the subset of program information is appended to the program information for the given program.”

By contrast, the Matthews reference fails to disclose, teach or suggest appending the subset of program information to the program information for a given program. The Patent Office refers to column 9/line 34 to column 10/line 20 of the Matthews reference as disclosing that, “as the user clicks on the program information of the given program, the subset of program information is displaying.” However, the “subset of program

information” to which the Patent Office refers, as described by the Matthews reference column 9, line 34 to column 10, line 20, is either descriptive text about the given program or hyperlinks to websites and does not include appending the subset of program information, including program information associated with the subset of program information, to the program information of the given program.

Dependent claim 8 recites providing information on programs related through the at least one related program and associated with the subset of program information for the at least one related program to a user; obtaining user input based on the information provided; and performing program events based on the user input.

By contrast, the Matthews reference fails to disclose, teach or suggest “providing information on programs related through the at least one related program and associated with the subset of program information for the at least one related program.” The Patent Office refers to Fig. 5, and column 9/line 55 to column 10/line 14 of the Matthews reference as disclosing the providing of information associated with the subset of program information for the at least one related program. The Patent Office argues that this is accomplished by the “MORE” 140 hyperlink, the “Last week” hyperlink and the “Comedy Club” hyperlink of the Matthews reference, which a viewer can access through the EPG.

By integrating the hyperlinks within the EPG UI, the viewer can readily identify supplemental information to the programs and access that information directly from the EPG. The viewer no longer needs to remember that there may be a Web site associated with a particular program or channel, nor is the viewer relegated to surfing the Internet from a separate machine to find any related content.

Matthews column 4, lines 59-67 (emphasis added). This passage recites the providing of hyperlinks to “a Web site associated with a particular program” and not providing information on programs related through the at least one related program and associated with a subset of program information for an at least one related program.

Dependent claim 9 recites “a recording device.”

By contrast, the Matthews reference fails to disclose such a “recording device.” The Patent Office refers to Fig. 8/item 216, and column 9/lines 45-55 of the Matthews

reference as disclosing a recording device. However, Fig. 8, step 216 indicates only a procedure to “initiate recording procedures.” Further, the written description of step 216, located at column 12, line 27 of the Matthews reference discloses only “to initiate a routine which will record the program.” Further, the Matthews reference does not identify initiating a recording routine for anything but the given program. Additionally, the Patent Office refers to column 9, lines 45-55 of the Matthews reference as disclosing a recording device. This passage reads:

by the headend 22 from the EPG server 44. The data maintained in data structure 48 (Fig. 2) is transmitted as program records to the user interface unit and cached in local memory. Data records for upcoming programs can be downloaded on a periodic basis, or alternatively, individual data records for certain programs and channels can be selectively transmitted in response to viewer requests. The EPG 104 inserts the appropriate data records into the EPG UI for display as the viewer maneuvers the focus frame 126 around the grid.

Matthews column 9, lines 45-55 (emphasis added). Nowhere in this Matthews reference is a recording device taught, disclosed or suggested. Instead, the cited passage is discussing “data records” for “upcoming” or “certain” programs.

Dependent claim 10 recites “wherein the subset of program information is appended to the program information for the given program.”

By contrast, the Matthews reference fails to disclose, teach or suggest appending the subset of program information to the program information for a given program. The Patent Office refers to column 9/line 34 to column 10/line 20 of the Matthews reference as disclosing that, “as the user clicks on the program information of the given program, the subset of program information is displaying.” However, the “subset of program information” to which the Patent Office refers, as described by the Matthews reference column 9, line 34 to column 10, line 20, is either descriptive text about the given program or hyperlinks to websites and does not include appending the subset of program information, including program information on programs related through the at least one related program and associated with the subset of program information for the at least one related program, to the program information of the given program, as disclosed by the instant application.

Claims 11-19 recite “a computer readable medium tangibly embodying a program of instructions implementing the method above ... in an information handling system; providing information on programs related through the at least one related program and associated with the subset of program information for at least one related program” and “a signal tangibly embodied in a propagation medium comprising at least one instruction configured to maintain, in an electronic program guide (EPG), a subset of program information for at least one related program of a given program with program information for the given program; at least one instruction configured to provide information on programs related through the at least one related program and associated with the subset of program information for the at least one related program; and at least one instruction configured to perform at least one program event for the given program and, based upon the subset of program information, the at least one related program and the information associated with the subset of program information for the at least one related program.” (emphasis added).

By contrast, the Matthews reference fails to disclose, teach or suggest maintenance in an electronic program guide (EPG), of information on programs related through the at least one related program and associated with the subset of program information for at least one related program. The Patent Office refers to the reasons given in the scope of method and system claims 1-10 for making these rejections. However, these rejections fail for the same reasons as stated for the failure of the rejections of claims 1-10.

As the Office is aware, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Office may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

The mere fact that the prior art may be modified in the manner suggested by the Patent Office does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or

‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

In the present case, the Office has selected portions from two references to arrive at the present invention; however, neither reference supplies the motivation for combining the references as proposed. Rather, the references are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the references do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

In making the rejection under 35 U.S.C. § 103, the Patent Office first asserts Matthews for disclosing a method for performing events for related programs. The Patent Office correctly notes that Matthews does not explicitly teach a “providing information on programs related through the at least one related program and associated with the subset of program information for the at least one related program” and offers Mao to correct this defect of the Matthews reference. The Patent Office states that it would have been obvious to modify Matthews according to Mao. However, Mao teaches a one-way digital television broadcast system which provides a menu for navigating to related program information, i.e., advertisement related to programs being watched or news related to the program being watched (Fig. 1, col. 3/lines 20-34 and col. 4/lines 33-58), while Matthews teaches an electronic program guide (EPG) with hyperlinks to target resources. Neither of the references teaches or suggests combining the navigable menu capabilities of Mao with the EPG system of Matthews.

Further, even if the references could be combined, the combination would not provide the claimed invention. A navigable menu of Mao combined with the EPG with hyperlinks of Matthews does not teach or suggest the present claimed invention. Rather than the providing of information on programs related through the at least one related program and associated with the subset of information related to the given program disclosed by the present invention, the combination of the above references would

provide essentially the same search system that allowed the user to navigate a menu and access hyperlinks for information associated with the given program. Thus, the references fail to provide the claimed invention and carry the burden of showing obviousness.

Therefore, applicant respectfully submits that the rejection of claims 1 through 19 under 35 U.S.C. 103(a) be withdrawn and pending claims 1 through 19 be allowed.

CONCLUSION

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

Respectfully submitted on behalf of
Gateway, Inc.

Dated: September 15, 2003

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